

REMARKS

Without disclaimer and prejudice, original claims 1-66 have been cancelled and their subject matter have been rewritten into new claims 67-129 to, for example, conform to U.S. patent practice. Support for those amendments can be found in the original claims and in the specification, for example, at page 15, lines 8-11, and at page 34, lines 12-19, in the specification as filed. There is no issue of new matter. In addition, at the Office's request for corrective action regarding original "use" claims 65 and 66, Applicants hereby submit that those two claims, allegedly drawn to non-statutory subject matter, have been deleted and currently all claims have been drawn to statutory subject matter. With entry of these amendments, claims 67-129 are pending before the Office.

In a Restriction Requirement, mailed April 1, 2009, the Office requires restriction under 35 U.S.C. 121 and 372 between the following groups:

Group I - Claims 1 and 3-56, allegedly drawn to a cosmetic composition comprising a styrene-free film-forming linear block ethylenic polymer; and

Group II- Claims 2-56, allegedly drawn to a cosmetic composition comprising a non-elastomeric film-forming linear block ethylenic polymer; and

Group III- Claims 57-63, allegedly drawn to an assembly comprising either the composition of Group I or II; and

Group IV- Claim 64, allegedly drawn to a process for caring for keratin materials by the application of the compositions of either Group I or II; and

Group V- Claim 65, allegedly drawn to a use of the composition of Groups I and II for the purpose of having the composition of Groups I and II applied to the skin or lips; and

Group VI- Claim 66, allegedly drawn to a use of a styrene-free and/or non-elastomeric film-forming linear block ethylenic polymer in a cosmetic composition in order to arrive at the composition being applied to the skin or lips. See Office Action at 2.

Specifically, in support of the Restriction Requirement, the Office alleges that “[t]he common technical feature linking the claims is a film-forming linear block ethylenic polymer. This element cannot be a special technical feature under PCT Rule 13.2”, because that element is described in the alleged prior art - U.S. patent No. 6,153,206 to Anton et al. The Office thus concludes that the restriction as indicated is proper. Applicants respectfully disagree.

Contrary to the Office’s allegations, Applicants respectfully submit that the currently claimed inventions do share a special technical feature. That is, each of the new claims requires a film-forming linear block ethylenic polymer that is distinguished from Anton, as discussed in the next paragraph. Accordingly, all of the claims form a single general inventive concept and satisfy the requirements for Unity of Invention under PCT Rule 13.1. MPEP, Appendix AI (Administrative Instructions under the PCT), Annex B, Part 1, subsection (b); Rule 13.2.

Anton describes a polymer comprising a first repeat unit (first monomer) and a second repeat unit (second monomer). Anton discloses that the polymer may be a block copolymer, without further discussing any particulars regarding the nature of the block copolymer. Although some of the copolymers listed in the table in col. 4, for example, the copolymers in line 50, IIIIIIIBBBBB, and line 58, IIIIIIIBBBBBBMMMMMM, can be considered as linear block polymers, those linear block polymers differ from the instantly claimed linear block polymers. For example, the intermediate segment of the claimed block polymers is a random copolymer, whereas the intermediate segment of Anton’s block polymers (for example, -IIBB-, and -BBMM-) is not a random copolymer. Furthermore, at most, only one of the at least one first block and the at least one second

block of the instantly claimed block polymer has a glass transition temperature of over 40 °C, whereas all of the blocks of Anton's block polymers as listed in the table in col. 4 have a glass transition temperature of over 40 °C. For example, the block polymers in line 50, IBBBBBBB and line 58, IBBBBBBBMMMM are derived from repeat units (for example, I, B, and M), when each polymerized to form a homopolymer block, having a glass transition temperature above 40 °C (53°C, 105 °C, and 105°C for blocks IBBBBB, BBBBBB, and MMMMM, respectively). Accordingly, Anton does not teach or fairly suggest the film-forming linear block ethylenic polymer as recited in new claims 67 or 68. Furthermore, Anton does not teach or suggest a polydispersity index as recited in the pending claims.

Hence, the currently claimed inventions as a whole represent a contribution over the alleged prior art. Accordingly, the Restriction Requirement is improper and should be withdrawn.

While Applicants traverse the Restriction Requirement, to be fully responsive, Applicants provisionally elect to prosecute the subject matter of Group I, new claims 67, and 69-119, corresponding to original claims 1, and 3-56, drawn to a cosmetic composition comprising, *inter alia*, at least one styrene-free film-forming linear block ethylenic polymer.

The Office also requires election of certain species to be examined and to identify the claims encompassing those species, regardless of which of the above groups is elected. See Office Action at 3 - 8. Specifically, the Office requires the election of

- 1) a species of glass transition temperature for both the first block and the second block,
- 2) a species of the presence or absence of the additional monomer,
- 3) a species of the presence or absence of the volatile oil, and
- 4) a species of the presence or absence of the non-volatile oil.

The Office further requires specific additional monomer, volatile oil, or non-volatile oil to be elected if presence of additional monomer, volatile oil, or non-volatile oil is elected.

Specifically, in an attempt to support the Election of Species Requirement, the Office alleges that the special technical feature linking the genera is the glass transition temperature for the polymer, additional monomers, and the volatile and non-volatile oils. However, the Office argues that these elements cannot be considered as special technical special feature under PCT Rule 13.2 because they have been described in Anton, thus requiring election of species for prosecution on the merits. See Office Action at page 4. Applicants respectfully disagree and traverse this Requirement.

As discussed above, Anton does not teach or fairly suggest the film-forming linear block ethylenic polymer as claimed herein, which is a special technical feature existing among the claims. Furthermore, Applicants respectfully assert that it would be eminently feasible for the Office to search and examine all of the claims together. This is, for example, because all of the claims recite that block polymer. Accordingly, Applicants respectfully submit that the Office's election requirement is improper and should be withdrawn.

While Applicants traverse the Election of Species Requirement, to be fully responsive, Applicants provisionally elect

1) a species of a Tg of greater or equal than 40° C for the first block and of a Tg of less or equal than 20° C for the second block, encompassed by new claims 67, 69-76, 82-91, and 96-119;

2) a species of the presence of the additional monomer, wherein the specific additional monomer is acrylic acid, encompassed by new claims 96-100;

3) a species of the presence of the volatile oil, wherein the specific volatile oil is isododecane, encompassed by new claims 108-110; and

4) a species of the presence of the non-volatile oil, wherein the specific non-volatile oil is a hydrocarbon-based non-volatile oil, encompassed by new claims 111-113.

Applicants respectfully request that the full scope of the claimed invention continue to be examined in this application without the restriction or election requirement. If the Office chooses to maintain the election requirement, Applicants respectfully request the Office, if the elected species is found allowable, to continue to examine the full scope of the subject matter to the extent necessary to determine the patentability thereof, that is, extending the search to a reasonable number of the non-elected species according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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